



JFW

MAY 25 2007

PTO/SB/21 (08-00)

## TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

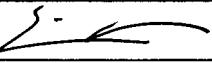
Total Number of Pages in This Submission

Application Number	10/625,904
Filing Date	July 24, 2003
First Named Inventor	Ritsuko KAWASAKI et al.
Group Art Unit	2826
Examiner Name	A. Sefer
Total Number of Pages in This Submission	0756-7181

**ENCLOSURES (check all that apply)**

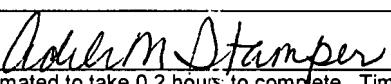
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Assignment Papers <i>(for an Application)</i> <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Declaration and Power of Attorney <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group <i>(Appeal Notice, Brief, Reply Brief)</i> <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosures 1. 2. 3. 4. 5. 6.
<b>Remarks</b> <input checked="" type="checkbox"/> The Commissioner is hereby authorized to charge any additional fees required or credit any overpayments to Deposit Account No. 50-2280 for the above identified docket number.		

**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

Firm or Individual name	Eric J. Robinson, Reg. No. 38,285 Robinson Intellectual Property Law Office, P.C. PMB 955 21010 Southbank Street Potomac Falls, VA 20165
Signature	
Date	May 23, 2007

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date indicated below.

Type or printed name	Adele M. Stamper		
Signature		Date	May 23, 2007

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.



Attorney Docket No. 0756-7181

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:  
Ritsuko KAWASAKI et al.  
Serial No. 10/625,904  
Filed: July 24, 2003  
For: SEMICONDUCTOR DEVICE AND  
METHOD OF FABRICATING THE  
SAME

- ) Group Art Unit: 2826  
 ) Examiner: Ahmed Sefer  
 ) CERTIFICATE OF MAILING  
 ) I hereby certify that this correspondence is  
 ) being deposited with the United States Postal  
 ) Service with sufficient postage as First Class  
 ) Mail in an envelope addressed to:  
 ) Commissioner for Patents, P.O. Box 1450,  
 ) Alexandria, VA 22313-1450, on May 23, 2007.  
 ) Adeli M. Stamps

RESPONSE

Honorable Commissioner of Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

The Official Action mailed February 23, 2007, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Accordingly, the Applicant respectfully submits that this response is being timely filed.

The Applicant notes with appreciation the consideration of the Information Disclosure Statements filed on July 24, 2003; and August 11, 2003.

Claims 1-4 and 11-22 are pending in the present application, of which claims 1, 2, 11 and 12 are independent. The Applicant notes with appreciation the allowance of claims 11-14, 17, 18, 21 and 22 (page 4, Paper No. 20070215). For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

Paragraph 3 of the Official Action rejects claims 1-4, 15 and 16 as anticipated by U.S. Patent No. 5,763,904 to Nakajima. The Applicant respectfully traverses the rejection because the Official Action has not established an anticipation rejection.

As stated in MPEP § 2131, to establish an anticipation rejection, each and every element as set forth in the claim must be described either expressly or inherently in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

The Applicant respectfully submits that an anticipation rejection cannot be maintained against the independent claims of the present application. Independent claims 1 and 2 recite an island-like semiconductor layer covering a projection and extending over a pair of edges of the projection. For the reasons provided below, the Applicant respectfully submits that Nakajima does not teach the above-referenced features of the present invention, either explicitly or inherently.

Referring to Figures 24-31 of Nakajima, the Official Action asserts that the semiconductor layer 12 and thick region 24 of Nakajima correspond to the island-like semiconductor and projection of the present claims (pages 2-3, Paper No. 20070215). However, Nakajima appears to disclose that a pair of edges of the semiconductor layer 12 aligns with a pair of edges of the thick region 24 (Figure 26 reproduced below).

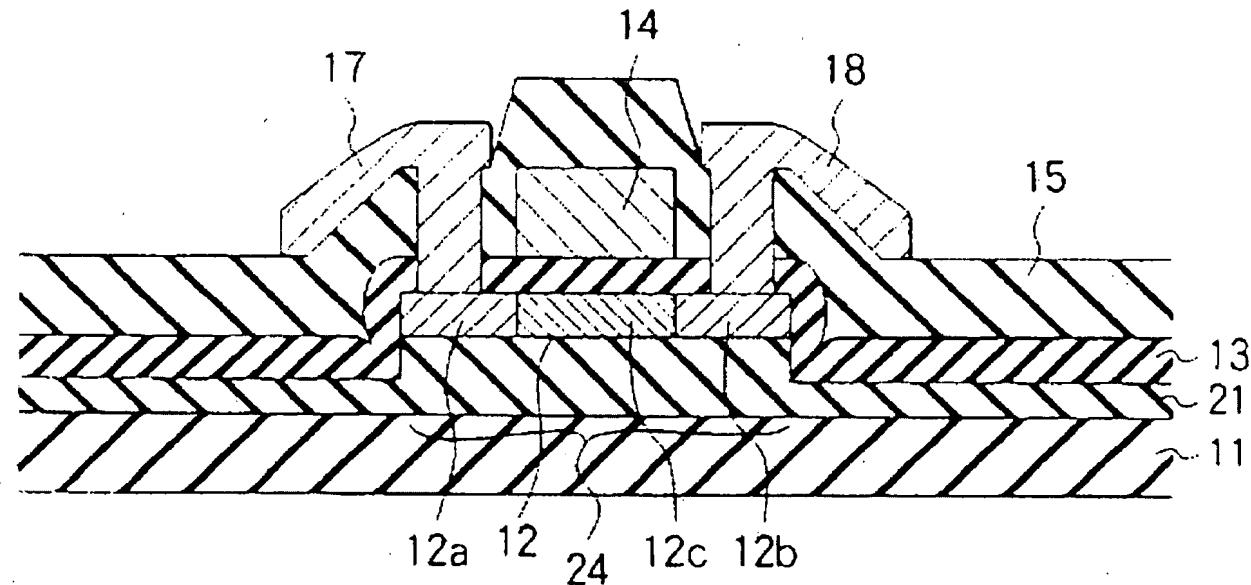


Figure 26 of Nakajima does not teach that the semiconductor layer 12 extends over a pair of edges of the thick region 24. Also, Figures 24, 25 and 27-31 of Nakajima

do not teach that the semiconductor layer 12 extends over a pair of edges of the thick region 24.

Therefore, the Applicant respectfully submits that Nakajima does not teach an island-like semiconductor layer covering a projection and extending over a pair of edges of the projection, either explicitly or inherently.

Since Nakajima does not teach all the elements of the independent claims, either explicitly or inherently, an anticipation rejection cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 102 are in order and respectfully requested.

Paragraph 6 of the Official Action rejects claims 19 and 20 as obvious based on Nakajima and Official Notice. (Although the Official Action refers to "Chen" three lines from the bottom of page 3, it appears that this is a typographical error, since Chen was the subject of the previous Official Action and is not otherwise discussed in the present Official Action.) The Applicant respectfully traverses the rejection because the Official Action has not made a *prima facie* case of obviousness.

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365,

1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Please incorporate the arguments above with respect to the deficiencies in Nakajima. Official Notice does not cure the deficiencies in Nakajima. The Official Action relies on Official Notice to allegedly teach the features of the dependent claims. Specifically, the Official Action relies on Official Notice to allegedly teach that it would have been obvious to incorporate Nakajima's display into a personal computer, a video camera or a digital camera (page 4, Paper No. 20070215). However, Nakajima and Official Notice, either alone or in combination, do not teach or suggest the following features or that Nakajima should be modified to include any of the following features: an island-like semiconductor layer covering a projection and extending over a pair of edges of the projection. Since Nakajima and Official Notice do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

  
Eric J. Robinson  
Reg. No. 38,285

Robinson Intellectual Property Law Office, P.C.  
PMB 955  
21010 Southbank Street  
Potomac Falls, Virginia 20165  
(571) 434-6789